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10/045,649	11/07/2001	Nobuyoshi Morimoto	5596-00901	9861

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Robert C. Kowert
Conley, Rose & Tayon, P.C.
P.O. Box 398
Austin, TX 78767

EXAMINER

RAPILLO, KRISTINE K

ART UNIT	PAPER NUMBER
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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/045,649	Applicant(s) MORIMOTO, NOBUYOSHI	
	Examiner KRISTINE K. RAPILLO	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/11/2002; 6/25/2002; 1/13/2003; 1/21/2003;</u> | 6) <input type="checkbox"/> Other: _____ |
| <u>8/18/2003; 12/16/2003; 2/5/2004.</u> | |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed May 12, 2008. Claims 1, 8, 10, and 19 – 20 are amended. Claims 1 - 20 are pending.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1e - 40l; Figure 1k – 25; Figure 7 – 166; Figure 8 -194; and, Figure 10 - 318 and 322. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "65 - 69" has been used to designate both recipient and sender information in Figure 4; Reference Character "69 has been used to designate both Sender Telephone and Sender Account in paragraph [0060] of specification; and, Reference Character "192" has been used to designate both "communicate new route" and "verification of original route" in paragraph [0089] of specification.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 100b through 122b (paragraphs [0070] through [0074] of specification) and 186 (paragraph [0089] of specification).

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "cost effective" is vague and indefinite. Cost effective is a subjective phrase, thus its interpretation is dependent upon the senders (or originators) need (i.e. overnight would be more expensive, but cost effective). Claims 2 - 18 are dependent upon claim 1 and therefore are rejected for substantially the same reason.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1 - 18 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). For instance, the method steps recited in the body of claim 1 could reasonably be interpreted to encompass a human being performing these steps; the phrase memory device could be interpreted as a piece of paper. Claims 2 - 18 have similar deficiencies as noted above with regard to claim 1 and therefore are rejected for substantially the same reason.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 – 2, 4 – 9, and 12 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell et al., herein after Harrell (U.S. Publication Number 2002/0156656 A1) in view of Vaghi (U.S. Patent Number 6,047,273).

In regard to claim 1 (Currently amended), Harrell teaches a method for arranging insurance for an item to be shipped from an origination to a final destination, wherein the method comprises:

receiving a request, wherein the request is a request to insure the item during shipment from the origination to the final destination (Figures 2 and 9; paragraphs [0005], [0031], [0041], and [0043]) where high risk ports (destination) are taken into consideration when requesting and generating a quote for insurance);

generating a data file (Figure 1) comprising at least the following:

item information indicative of the item (paragraph [0043]) where data is input regarding the commodity (i.e. item), and

insurer information indicating one or more terms of insurance (Figures 2, 4, and 5; paragraph [0048]; and, Tables 3, 4, 9, and 10); and

storing the data file in a memory device that accompanies the item during shipment (Figure 1).

Figure 1 illustrates the process for requesting and generating a quote, including “stored data” which is equated to a data file.

Harrell fails to teach a method comprising searching a database for a cost effective insurance for the item, wherein the cost effective insurance provides a specified level of insurance coverage for the item during shipment.

Vaghi teaches a method comprising searching a database for a cost effective insurance for the item, wherein the cost effective insurance provides a specified level of insurance coverage for the item during shipment (column 5, line 21 through column 6, line 32) where Vaghi discloses a database of

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options, including insurance options. The Examiner interprets insurance options as the various levels and types of insurance available to a shipper or sender.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method comprising searching a database for a cost effective insurance for the item, wherein the cost effective insurance provides a specified level of insurance coverage for the item during shipment as taught by Vaghi, within the method of Harrell, with the motivation of providing a tool to enable customers to remotely use a mailing/shipping service via the use of a rate table (column 2, line 65 through column 3, line 17).

In regard to claim 2 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Vaghi teaches a method wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment (Figure 3; column 7, lines 5 – 15; and, claim 39).

The motivation to combine the teachings of Vaghi and Harrell is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 4 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Vaghi teaches a method further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at least one insurance company (Figure 6; column 3, lines 43 – 65; column 11, lines 48 – 57; and, claim 5).

The motivation to combine the teachings of Vaghi and Harrell is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 5 (Original), Harrell and Vaghi teach the method as recited in claim 1. Harrell teaches a method further comprising forwarding copies of the data file via the network to one or more predetermined email addresses (paragraph [0041]).

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In regard to claim 6 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Vaghi teaches a method further comprising forwarding a copy of the data file via a network to a central server (column 4, lines 7 – 28).

The motivation to combine the teachings of Vaghi and Harrell is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 7 (Original), Harrell and Vaghi teach the method as recited in claim 1. Harrell teaches a method further comprising shipping the item using the least expensive routing (Figure 2) where Harrell discloses modifications can determine the least expensive routing (i.e. lower premiums).

In regard to claim 8 (Currently amended), Harrell and Vaghi teach the method as recited in claim 1. Harrell further teaches a method wherein the data file further comprises contact information for at least one insurance companies that will provide said insurance (Figures 12 and 14) where Harrell discloses a reinsurer is notified in Figure 12, thus it is reasonable to conclude that the reinsurers contact information is available. In addition, Figure 14 illustrates contact of a claims representative and underwriter.

In regard to claim 9 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Vaghi teaches a method further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (column 8, lines 40 – 50 and claim 39).

The motivation to combine the teachings of Vaghi and Harrell is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 12 (Original), Harrell and Vaghi teach the method as recited in claim 1.

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Vaghi teaches a method wherein the data file further comprises item weight information (column 5, line 21 through column 6, line 30).

The motivation to combine the teachings of Vaghi and Harrell is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 13 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Vaghi teaches a method wherein the data file further comprises item handling information (column 5, line 21 through column 6, line 30).

The motivation to combine the teachings of Vaghi and Harrell is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 14 (Original), Harrell and Vaghi teach the method as recited in claim 1. Harrell teaches a method wherein the data file further comprises item content information (paragraph [0043]) where content is equated to commodity.

In regard to claim 15 (Original), Harrell and Vaghi teach the method as recited in claim 1. Harrell teaches a method wherein the data file further comprises insurance information (paragraph [0043]) where the file contains the amount insured (i.e. insurance information).

System and storage claims 19 and 20 repeat the subject matter of claims 1, 2, and 6. As the underlying processes of claims 1, 2, and 6 have been shown to be fully disclosed by the teachings of Harrell and Vaghi in the above rejections of claims 1, 2, and 6; as such, these limitations (19 and 20) are rejected for the same reasons given above for claims 1, 2, and 6 and incorporated herein.

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11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell (U.S. Publication Number 2002/0156656 A1) in view of Vaghi (U.S. Patent Number 6,047,273) as applied to claim 1 above, and further in view of Welles et al., herein after Welles (U.S. Patent Number 5,686,888).

In regard to claim 3 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Welles teaches a method further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier (column 6, lines 4 – 23) where Welles discloses attaching a sensor to each piece of cargo within a container.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier with the motivation of monitoring the condition and/or integrity of good being shipped (abstract).

12. Claims 10 – 11 and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell (U.S. Publication Number 2002/0156656 A1) in view of Vaghi (U.S. Patent Number 6,047,273) as applied to claim 1 above, and further in view of Bennett et al., herein after Bennett (U.S. Patent Number 7,117,170).

In regard to claim 10 (Currently amended), Harrell and Vaghi teach the method as recited in claim 1.

Bennett teaches a method wherein storing the data file comprises storing the data file in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein storing the data file comprises storing the data file in an XML format as taught by Bennett, within the method of Harrell and Vaghi, with the motivation of providing the capability of tracking, storing, and transmitting the information over a shipment carriers web server (column 55, lines 46 – 62)

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In regard to claim 11 (Previously presented), Harrell and Vaghi teach the method as recited in claim 9.

Bennett teaches a method wherein the network data is exchanged in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

The motivation to combine the teachings of Harrell, Vaghi, and Bennett is discussed in the rejection of claim 10, and incorporated herein.

In regard to claim 16 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item before, during, or after shipping (column 28, line 60 through column 29, line 10).

The motivation to combine the teachings of Harrell, Vaghi, and Bennett is discussed in the rejection of claim 10, and incorporated herein.

In regard to claim 17 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (column 48, lines 43 – 57).

The motivation to combine the teachings of Harrell, Vaghi, and Bennett is discussed in the rejection of claim 10, and incorporated herein.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell and XXX as applied to claim 1 above, and further in view of Kepler (U.S. Patent Number 5,347,845).

In regard to claim 18 (Original), Harrell and Vaghi teach the method as recited in claim 1.

Harrell and Vaghi fail to teach a method wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file.

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Kepler teaches a method wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file (column 2, lines 25 - 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file as taught by Kepler, within the method of Harrell and Vaghi, with the motivation of detecting the presence of contaminants in shipping containers (Abstract).

Response to Arguments

14. Applicant's arguments filed May 12, 2008 have been fully considered but they are not persuasive. The Applicant's arguments are moot in view of the new grounds of rejection and new prior art.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- Kara (U.S. Patent Number 6,233,568) teaches a system and method for automatically providing shipping/transportation fees in which postage or other authorization information is dispensed electronically using a portable processor containing a maximum amount of preauthorized postage which can be applied to any piece of mail or other item.
 - Duncan (U.S. Patent Number 6,934,692) teaches an on-line interactive system and method for transacting business over a network between multiple buyers and sellers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/Robert Morgan/
Primary Examiner, Art Unit 3626